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In re application of: Thomas ~~Thomas~~ SCHERB et al

Attorney Docket No. P24575

Application No. : 10/743, 461

Mail Stop Appeal-Patents
Group Art Unit: 8138

Filed : December 23, 2003

Examiner: E. Hug

For : **MACHINE AND METHOD FOR THE MANUFACTURE OF A FIBER MATERIAL WEB**

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop **Appeal Brief-Patents**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is an **Reply Brief 37 C.F.R. 41.41** in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ An Information Disclosure Statement, PTO Form 1449, and references cited.

☐ A Request for Extension of Time.

☐ No additional fee is required.

☒ Request for Oral Hearing.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 33	*33	0	x25=	\$	x 50=	\$0.00
Indep. Claims: 1	**3	0	x100=	\$	x200=	\$0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$0.00
Extension Fees for ___ Month(s)				\$		\$0.00
Oral Hearing						\$1,000.00
* If less than 20, write 20			Total:	\$	Total:	\$1,000.00
** If less than 3, write 3						

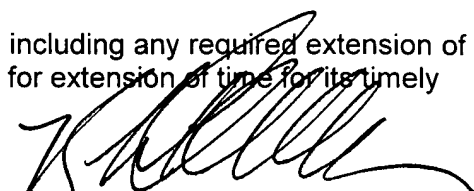
☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

☒ A check in the amount of \$1,000.00 to cover the filing fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Thomas Thoroe SCHERB *et al.*

Confirmation No.: 8138

Appln. No. : 10/743,461

Group Art Unit: 1731

Filed : December 23, 2003

Examiner: Eric J. Hug

For : MACHINE AND METHOD FOR THE MANUFACTURE OF A FIBER
MATERIAL WEB

REPLY BRIEF UNDER 37 C.F.R. 41.41

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief- Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This Reply Brief is in response to the Examiner's Answer dated December 21, 2005, the period for reply extending until February 21, 2006.

Appellants submit that no fee is required for the filing of the instant Reply Brief. However, if for any reason a necessary fee is required for consideration of the instant paper, the Commissioner is authorized to charge the fee for the Reply Brief and any necessary extension of time fees to Deposit Account No. 19-0089.

In the Examiner's Answer, the Examiner has maintained the grounds of rejections advanced in the final rejection and provides arguments in support thereof.

Appellants note this Reply Brief is being filed under 37 C.F.R. 41.41 and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellants note they are addressing points made in the

Examiner's Answer and not merely repeating the arguments set forth in the Appeal Brief.

1. *Edwards Does Not Use Conventional Shoe Press as Intermediate Step*

In explaining the rejection of claims 1 – 4, 7 – 21 and 24 – 32 under 35 U.S.C. § 102(e) as anticipated by EDWARDS, the Examiner, in Section 10 (*Response to Argument*) on page 9, asserts that the combination of a conventional press shoe with a Yankee dryer disclosed in EDWARDS does not teach away from the present invention, but is merely an intermediate step towards obtaining a preferred press arrangement.

Appellants submit that there is no substantiation of the Examiner's assertions found in EDWARDS. That is, EDWARDS does not purport to build upon the conventional shoe press, but instead expressly discloses that the conventional shoe press is not suited for operation in the environment that EDWARDS seeks to employ it, i.e., pressing against a Yankee dryer. Because the conventional shoe press is not suited to provide the desired results in the intended environment of operation, EDWARDS utilizes a "new" shoe design, in which a smaller shoe exerts a higher nip load, as compared to the conventional shoe.

Appellants submit that this "new" design by EDWARDS does not use the conventional shoe press as an intermediate step, as asserted by the Examiner, but only as a failed attempt. In particular, because EDWARDS discloses in col. 5, lines 58 – 60 that the "counter roll in a conventional shoe press is small by comparison to the diameter of a Yankee dryer," logic would appear to dictate that one would increase the length of shoe for use with the larger diameter Yankee dryer. However, as EDWARDS discloses a smaller shoe with higher nip load, there is no disclosure of EDWARDS

utilizing the conventional shoe as an intermediate step in formulating his “new” shoe, nor does there appear to be any rationale basis to assert that EDWARDS utilized the conventional shoe press as an intermediate step, as asserted by the Examiner.

Moreover, Appellants submit that EDWARDS is unmistakable in its disclosure that the conventional shoe will not provide useful results when pressed against a Yankee dryer, such that EDWARDS emphatically teaches that the conventional shoe press in conjunction with a Yankee dryer will not achieve the necessary drying requirements.

2. *Edwards Does Not Disclose Operation at a Peak Pressure Below or Equal to Approx. 2MPa*

In Section 10 (*Response to Argument*) on page 10 of the Examiner’s Answer, the Examiner asserts the “new” press shoe with the Yankee dryer in EDWARDS exhibits a length greater than approximately 80 mm and operation at peak pressure of less than or equal to approximately 2 MPa.

However, as disclosed in EDWARDS at col. 17, lines 3 and 6, the peak pressure in the shoe is greater than about 2000 kN/m^2 , which is contrary to the expressly recited features of the instant invention, which is less than or equal to about 2 MPa. Thus, EDWARDS discloses a minimum peak pressure greater than the maximum peak pressure recited in the pending claims. Moreover, Appellants note that, while EDWARDS provide ample teaching of utilizing a peak pressure significantly greater than 2000 kN/m^2 , EDWARDS provides no teaching or suggestion for operation below the disclosed minimum peak pressure of 2000 kN/m^2 .

Still further, while disclosing a number of shoe lengths and peak pressure ranges, EDWARDS does not provide any teaching to enable one ordinarily skilled in the

art to make or use the invention outside of the disclosed parameters. Because the recited maximum peak pressure of the pending claims is less than the minimum peak pressure of EDWARDS, Appellants submit that EDWARDS is not enabling with regard to the recited features of the present invention, and should be withdrawn.

Accordingly, because the minimum peak pressure of EDWARDS is greater than the maximum peak pressure recited in the pending claims, Applicants submit that the instant rejection should be reversed and remanded to the Examiner for allowance.

3. *Edwards Fails to Disclose a Single Operable Embodiment to Anticipate the Pending Claims*

Further, Appellants note that, with the exception of the example shown in Figure 3, EDWARDS does not provide any guidance regarding the manner in which one ordinarily skilled in the art would combine the pressure and shoe length, and certainly no disclosure for combining the pressure and shoe length in any manner that would anticipate the instant invention.

That is, while EDWARDS discloses in col. 16, lines 43 – 45 that the shoe element length can be less than about 7 inches but is more preferably less than about 3 inches, it is not apparent whether the above-discussed minimum peak pressure, which is greater than the recited maximum peak pressure for the present invention, is utilized in conjunction with a shoe element length of less than 3 inches, which is not greater than the recited 80 mm, or whether it is utilized with a shoe of less than 7 inches. Appellants submit that, while a range of shoe lengths and peak pressure ranges are disclosed, with the exception of the example of a 50 mm shoe and a peak pressure of 4.5 MPa, EDWARDS does not provide any teaching to enable one ordinarily skilled in

the art, without undue experimentation, to make or use the invention, i.e., to associate specific shoe lengths with specific peak pressures.

Thus, Appellants submit that EDWARDS fails to disclose an operable embodiment that anticipates the recited features of the pending claims. In this regard, Appellants submit that the only operable example in EDWARDS provided utilizes a shoe length of 50 mm and a maximum peak pressure of 4.5 MPa, neither of which is within the scope of the pending claims.

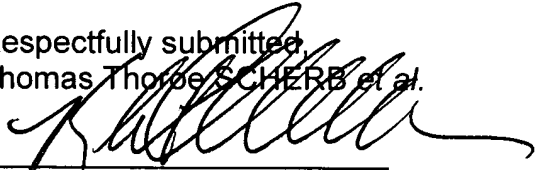
Accordingly, as EDWARDS fails to disclose a single operable embodiment that anticipates the combination of features recited in the pending claims, Appellants submit that, for this additional reason, the pending rejection should be reversed and remanded to the Examiner for allowance.

CONCLUSION

For the reasons expressed above, Appellant respectfully requests that the grounds of rejection advanced by the Examiner be reversed. Appellant further requests that the application be returned to the Examining Group for prompt allowance.

Although neither a fee nor an extension of time is believed to be due with this Reply Brief, if an extension of time is necessary, Appellant respectfully requests an extension of time under 37 C.F.R. 1.136(a) for as many months as would be required to render this submission timely. Further, the Commissioner is hereby authorized to charge any additional fee due to Deposit Account No. 19-0089.

Respectfully submitted,
Thomas Thorpe SCHERB et al.


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February 21, 2006
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